

## REMARKS

The Examiner, in the outstanding Office Action, has raised concerns regarding claim 34 and the phrase “less than about”, and alleges that the phrase renders claim 34 indefinite. The Examiner has further cited the U.S. patents 5,991,637 (Mack, II et al.), 6,754,361 (Hall et al.) and 6,252,970 (Poon) and other patent references and asserts certain outstanding claims are unpatentable over Mack, II et al. in view of these references (including U.S. patents 6,016,347, 4,882,745 and 5,930,719).

The present Amendment and Request for Reconsideration is provided to fully address the issues identified by the Examiner. It is believed that this Amendment and Request for Reconsideration is fully responsive in light of the outstanding office action and accordingly is a bona fide attempt to advance the prosecution of the application.

### **Amendments to the Claims**

The Examiner is respectfully directed to claims 1, 34 through 38, 46, 49, 50, 53 through 56, 63 and 64 as the currently amended claims and newly presented claims 65 through 68. Claim 34 is amended to remove the term ‘about’. Claim 46 is amended to address a typographic error introduced by the omission of a period at the end of the claim sentence.

### **Concerning Claim 34 Under 35 U.S.C. Section 112, 2<sup>nd</sup> Paragraph**

The Examiner asserts that the phrase “less than about” is not defined by claim 1, the specification does not provide a standard to ascertain the requisite degree, and one of ordinary skill in the art would not be apprised of the scope of the invention. It is presently urged and was previously argued that the phrase “less than about” is sufficiently definite as disclosed in the specification and under the requirements of 35 U.S.C. section 112, 2<sup>nd</sup> paragraph. However, and without submitting to the rationale or rejection made by the Examiner, the Applicant amends claim 34 as incorporating claim limitations and claim coverage equal to the phrase “less than about.”

## **Prior Art Issues**

The Examiner has alleged that certain claims are made obvious by the Mach, II et al. patent reference in light of the above-cited references or notice taken by the examiner, all at least with view to Hall et al. It is presently asserted that the claims are novel and nonobviousness in light of the art of record, and accordingly the outstanding rejections based upon such references should be withdrawn.

The Examiner has identified that Mack et al. "does not teach the telephone control is pivotally connected to one of the distal ends of the headband." Outstanding Office Action, p. 4. Furthermore, the Examiner cites Hall et al. for the proposition that "Hall teaches an ergonomic headset assembly comprising an adjustable headband (110) and an electronics housing (120), the housing is pivotally coupled to the headband which allows the electronics housing to be swung away from a user's ear, figures 1 and 8, column 1, lines 10-57 and column 5, lines 35-55." Office Action, p. 4. The examiner cites the motivation to combine references as "to allow the electronics/earpiece/microphone to be swung away from a user's ear and provide additional comfort to the user." Office Action, p. 5.

The Examiner has also identified that Mack et al. "does not teach the telephone control is pivotally connected to one of the distal ends of the headband and configured to provide a hand-held configuration of the cordless telephone headset." Office Action, p. 6. The Examiner cites again Hall et al. for the proposition, among others, that "Hall discloses the electronic housing (120) may be pivoted away or detached from the headband (110) and used for communication, column 5, lines 47-66." Office Action p 6.

The Examiner is presently urged to reconsider the teaching and suggested motivation asserted in the outstanding Office Action, both as to the teaching of the claims as previously recited and as presently amended, and further with regard to the applicability of such motivation as it would be considered by one of ordinary skill in the art in light of the claimed features.

## **Previously recited claims**

As the Examiner is aware, the burden of the Examiner in establishing a *prima facie* case of obviousness includes establishing that all claim limitations are taught or suggested by the prior art. In re Royka, 490 F.2d 981 (C.C.P.A. 1974). It is urged that the cited references do not teach or disclose the invention as claimed in claims 1, 35, 37, and 63, and the dependent claims thereof.

However, a *prima facie* showing of the art teaching or suggesting may have not been made, both as to the claimed recitation of a telephone control as previously recited (claim 1, 37), or of a pivotal connection to one of the distal ends wherein the system provides a hand-held configuration of the cordless telephone headset as previously recited (claim 35, 63).

Furthermore, it may have been error to utilize the disclosure and motivation expressed by the Examiner for allowing electronics/earpiece/microphone to be “swung away from a user’s ear and provide additional comfort to the user”, as well as “to allow the electronics/earpiece/microphone to be moved away from the headband for alternative hand-held use by the user.” Office Action, pp. 5, 7. While comfort to the user may be a factor to consider generally in the industry, particularly for headsets and a user’s need for extended use of the headset, such motivation does not appear specifically applicable to operation of wireless communications headset technologies in a hand-held configuration, as taught for the present invention with one motivating purpose being the comfort of the user. Hall et al. col. 5, lines 43-45 (allows electronics package 120 to be positioned against the user’s ear during periods of use and swung away from the user’s ear during periods of *nonuse or as desired to increase the comfort of the user*) (emphasis added). This disclosure appears directed only to use of the Hall et al. technology as a head-worn technology, to increase comfort as a headset on the user’s head, and to allow detachment of the housing from the headband. Hall et al. col. 5, lines 64-65. Further, while motivation to move electronics away from a user’s ear while the headset remains on the user’s head may be found in Hall et al. as described above, the hinge and movement shown in Hall is not the pivoting features of the present invention nor disclosed for hand-held configuration, as may be applied for wireless communication headset technologies, but simply for increasing the comfort of the user when in use on the user’s head.

Particularly, disclosure of Hall et al. appears to be taught in column 5, lines 64 through 66, stating that “the housing 120 may be detached from the headband 110 and used for communication.” However, this teaching is far from the advantageous features of the present invention, new technology which may be embodied as wireless communication headset systems and the pivoting aspects of the headband and control, and further in relation to communication systems having head-worn and hand-held configurations. The only disclosure of Hall requires detaching the housing 120 from the headband 110, and even given that inapplicable disclosure, nothing is mentioned of a hand-held configuration. In fact, the only alternative use in swinging the housing away from the user’s ear is described as when “it is attached to a hat as well as a headband.” Hall et al., col. 5, lines 53-55.

As the Examiner is well aware, the basic requirements of a *prima facie* case of obviousness are the establishment of the suggestion or motivation to modify the cited references, a reasonable expectation of success, and all claim limitations must be taught or suggested. *See, for example*, MPEP section 2143 et seq. It is presently urged that features of the present invention directed to hand-held configurations and other aspects of the present invention are not taught or suggested by the art of record, no reasonable chance of success can be found from these references, and no motivation is found for technology disclosing or suggesting head-worn configurations.

### **Amended and newly presented claims**

The current amendment to the claims is presented to highlight some inventive, novel and nonobvious aspect of the present invention. The claims, both previously presented and currently amended, have supportive argument for novelty and nonobviousness as described above. However, in the interest of providing a full understanding of the technology of the present invention that may be embodied as a wireless communication headset system, further explanation is herein provided.

Claim 1 now recites, in part, “wherein said telephone control and said headband are pivotally rotatable from a head-worn configuration to a hand-held configuration of said cordless telephone headset system.” Claim 35 now recites, in part, the system features “are pivotally rotatable from a head worn configuration to a hand-held configuration of said cordless telephone headset.” Claim 37 now

recites, in part, “wherein said user configuration comprises a hand-held configuration and said telephone control and said headband are pivotally rotatable to said hand-held configuration.” Claim 63 now recites, in part, the system features “of said cordless telephone headset are pivotally rotatable to said hand-held configuration.” Each of these limitations further distinguish the present invention from the prior art.

In operation, and as but one example, the present invention may be embodied as a wireless communication headset system that may be operated as follows. A user may receive an incoming call or other communication or information through the technology. As an example, the user receives a telephone call. The user may then engage the system to answer the call and understand the identity of the caller and the likely purpose and substance of the telephone conversation. The user may then decide to remain in the telephone conversation and keep the system in its original configuration when the call was answered. The system may be in its original head-worn configuration, say when placed upon the base, or it may be in a hand-held configuration. In either event, the user may then decide to change the configuration of the system, in part based upon the expected telephone conversation and based upon other factors such as user preference and comfort. In one example, the user may elect not to mess their hair by using the system in a head-worn configuration and may pivotally rotate the headset to a hand-held configuration, either in initiating the call or after taking the call. The user may then elect to continue the conversation with the system in a hand-held configuration or revert to a head-worn configuration, for example if the conversation is expected to be lengthy and/or if the user expects the freedom of the use of both hands during the call. Furthermore, the headset of the wireless communication headset system may be configured from a head-worn configuration to a hand-held configuration at any point, based upon the user’s preference or changing preferences.

A further advantage of the technology is the dual configurations and the ability to wear the technology for an extended time or not, to opt for a hand-held configuration, and to be able to adjust or change from a head-worn configuration on the head, with associated tightness on the user’s head. Furthermore an additional advantage would be the capability to go from a head-worn configuration to a hand-held configuration, or the reverse, in order to adjust the physical pressure between the earpiece or ear cup and the user’s ear, thereby adjusting or even improving the reception of sound from the

technology to the user's ear by applying pressure on the technology, either by hand or by head configuration, to the user's head and ear. Accordingly, the technology uniquely allows the user to both adjust for better comfort or better audio reception in a way not heretofore understood from previous technologies.

The application provides disclosure for the use of the invention throughout the application; however, the Examiner is particularly directed to the specification, wherein operation and some novel and nonobvious aspects of the invention are further described.

#### **The present invention is not obvious in light of the prior art of record**

The Examiner has not shown or established that at the time the invention was made, all claim limitations are taught or suggested by the cited art, established the suggestion or motivation to modify or combine the cited references, even if the claim limitations were taught, or a reasonable expectation of success, with respect to the claimed recitations of claims 1, 35, 37, and 63.

As previously described and as explained by the Examiner in the outstanding Office Action, the Mack et al. reference does not teach claimed features of the present invention. Furthermore, as also previously described, the Hall et al. reference does not teach the missing claim limitations, does not provide motivation to modify or combine the cited references in any event, and provides no reasonable expectation of success even if such references were modified or combined.

Again, Hall et al. only discloses allowing electronics package 120 to be positioned against the user's ear during periods of use and swung away from the user's ear during periods of *nonuse or as desired to increase the comfort of the user*. Hall et al. col. 5, lines 43-45 (emphasis added). This disclosure is simply the use of the Hall et al. technology as a head-worn technology, to increase comfort as a headset on the user's head, and to allow detachment of the housing from the headband. Hall et al. col. 5, lines 64-65. Further, while motivation to move electronics away from a user's ear while the headset remains on the user's head may be found in Hall et al. as described above, the hinge and movement shown in Hall is not the pivoting features of the present invention nor disclosed for hand-

held configuration, but simply for increasing the comfort of the user when in use on the user's head.

Disclosure of Hall et al. appears to be taught in column 5, lines 64 through 66, stating that "the housing 120 may be detached from the headband 110 and used for communication." However, as explained previously, this teaching is not a telephone control and headband pivotally rotatable from a head-worn configuration to a hand-held configuration of a cordless telephone headset system, as claimed variously in the independent claims, and provides no motivation to combine any references in any event. The present invention, however, is new wireless communication headset technology and features pivoting aspects of the headband and control in relation head-worn and hand-held configurations. The only disclosure of Hall requires detaching the housing 120 from the headband 110, and even given that inapplicable disclosure, nothing is mentioned of a hand-held configuration. Again, the only alternative use in swinging the housing away from the user's ear is described as when "it is attached to a hat as well as a headband." Hall et al., col. 5, lines 53-55.

Furthermore, it is urged that the cited references do not disclose or suggest the invention as claimed in the dependent claims, and that dependent claims are novel and nonobvious as to the applied references. As the Examiner is also likely aware, if an independent claim is novel and nonobvious, the claims depending from the independent claims are also nonobvious. See In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). It is urged, therefore, that the dependent claims are novel and nonobvious as to the applied references at least as being dependent from the independent claims, respectively, as presented above, and further in view of the additionally recited limitations. However, as the independent claims are novel and nonobvious as to the applied references cited in the outstanding Office Action for at least the reasons provided above, accordingly, the Applicant respectfully requests the allowance of the independent and dependent claims.

### **Additional Cited References**

Mach, II et al. and Poon references do not suggest the desirability of the claimed invention. Mach, II et al. merely discloses hinged configurations of the headband for storage purposes, while Poon discloses rotation of body (30) to provide left or right configurations for user's head. Neither suggests

telephone control nor features pivotally connected to a distal end of the headband, and as recited in the claims. Furthermore, neither reference teaches or suggests a telephone control and headband pivotally rotatable from a head-worn configuration to a hand-held configuration of a cordless telephone headset system, as claimed variously in the independent claims, and provides no motivation to combine any references in any event. Even if it were assumed that the art cited taught all of the claim limitations, the motivation to combine the references and the desirability of the combination is not suggested by the prior art. *See MPEP 2143.01.*

Furthermore, and although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). No suggestion is presented in Mach, II et al. or Poon that would suggest providing the features as recited in the claims. Connection in Poon is provided for operable head configuration, while hinged configuration in Mack et al. is provided for storage purposes. Further, no suggestion is presented in Mack et al. or Poon that would suggest hand held configuration, and as recited in the claims. Configurations in Mach, II et al. are directed to head operation or storage while Poon teaches head operation and additionally inward earpiece/receiver configurations.

The Examiner is also respectfully requested to consider the invention as a whole in determining the differences between the prior art and the claims, as described and mandated in MPEP 2141.02. The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed Cir. 1983). The Court in the cited case identified that where prior art may have perceived a need for certain functionality, the inventor eliminated the need via the invention. *See case summary MPEP 2141.02.* “Because the insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art. *Stratoflex, Inc.* at 785.

As previously described in example above, the operation and features of the present invention provide for an entirely new solution for perceived need and functionality considered previously in traditional technologies. The applicant has eliminated these needs by providing a wireless communication headset technology that newly affords head-worn and hand-held configurations

heretofore contrary to the understanding and expectations of technologies taught in the cited references. These references, though in some ways addressing configurations of a headset and functionality thereof, either address only storage solutions, left and right head-worn configurations, swing an earpiece away from an ear while in a head-worn configuration for comfort, or require the detachment of electronics from the headband for other head-worn uses.

The present invention provides, in some embodiments, for a new wireless communication headset technology having features of a telephone control and headband pivotally rotatable from a head-worn configuration to a hand-held configuration of a cordless telephone headset system, as claimed variously in the independent claims, and telephone control and features pivotally connected to a distal end of a headband, as recited in the claims, to provide head-worn and hand-held configurations of the cordless telephone handset. Although folding for storage and rotation for head configuration, and adjustable configuration generally, may have been a perceived need, the Mach II, et al. and Poon references do not show an understanding or expectation of pivotal connection of telephone control or other novel features, as claimed, as the present invention provides. Given non-hindsight understanding of the complexity of telephone control and wireless communication headset technology at the time of the invention, such functionality may have been contrary to understandings and expectations of art and those in the field. Furthermore, although headset operation may have been perceived, the Mach II, et al. and Poon references do not show an understanding or expectation of hand-held configuration, as recited in the claims.

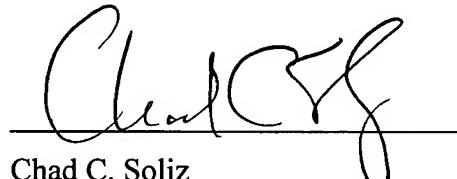
## CONCLUSION

Claims 1-64 are pending, claims 1, 34 through 38, 46, 49, 50, 53 through 56, 63 and 64 have been amended, and claims 65 through 68 are newly presented. In light of the above amendment and remarks, the Examiner's early reconsideration is earnestly requested.

If any outstanding issues remain with respect to this present amendment and request for reconsideration, the Examiner is respectfully requested to contact the undersigned attorney of record at his earliest convenience to initiate the resolution of any remaining concerns. However, the Applicant does respectfully request an immediate opportunity to interview with the Examiner in person at his earliest convenience regarding the outstanding office action and in support of this amendment and request for reconsideration.

Dated this 24 day of August, 2007.

Respectfully submitted,  
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